

# Notice of Allowability

Application No.

10/521,728

Examiner

Yong Chu

Applicant(s)

METE ET AL.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 06/28/2007.
2. ☒ The allowed claim(s) is/are 1,3-4,6,13,17, and 22 (renumbered as 1-7).
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All b) ☐ Some\* c) ☐ None of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date \_\_\_\_\_
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

## **DETAILED ACTION**

Claim 22 is new by the Amendment filed on 06/28/2007. Claims 14-16, and 18-21 are canceled by the Examiner's Amendment. Claims 1, 3-4, 6, and 13, 17, and 22 are pending.

### ***Response to Amendment***

The Amendments by Applicants' representative Robert C. Nabinger dated on 06/28/2007 has been entered.

### ***Response to Arguments***

#### **Rejection under 35 U.S.C. §102(b)**

The rejection of claims 1 and 6 obviated by the amendment to delete y is C<sub>1-4</sub>alkyl.

#### **Rejection under 35 U.S.C. §112(i)**

The rejection of claim 13 is obviated by the amendment to delete " a method for preventing" pain.

The rejection of claim 14 is moot, since the claim has been canceled.

#### **Rejection under 35 U.S.C. §112(ii)**

The rejection of claim 13 is obviated by the amendment to correct the redundant.

The rejection of claim 14 is moot, since the claim has been canceled.

**Examiner's Amendment**

An examiner's amendment to the record appears below with authorization by Applicant's representative Tony Zhang on 09/13/2007. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee. The application has been amended as follows:

Title, replace the old title "Novel compound" with a new one as "Substituted thiophene compounds".

In claim 1, on 2<sup>nd</sup> page, last line from the bottom, after "R<sup>5</sup>, R<sup>6</sup>, R<sup>7</sup> and R<sup>8</sup> independently represent H or C1 to 4 alkyl;", insert --and--.

In claim 13, delete ", comprising treating pain by administering " after "A method", and insert --of treating pain, comprising administering to a subject in need thereof --.

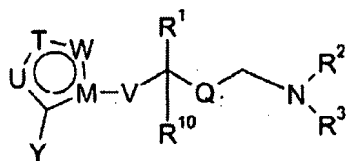
In claim 13, on 3<sup>rd</sup> page, last 3<sup>rd</sup> line from the bottom, after "R<sup>5</sup>, R<sup>6</sup>, R<sup>7</sup> and R<sup>8</sup> independently represent H or C1 to 4 alkyl;", insert --and--.

In claim 22, on 3<sup>rd</sup> page, last 3<sup>rd</sup> line from the bottom, after "R<sup>5</sup>, R<sup>6</sup>, R<sup>7</sup> and R<sup>8</sup> independently represent H or C1 to 4 alkyl;", insert --and--.

Delete claims 14-16, and 18-21.

**Reasons for Allowance**

The present invention is directed to a compound of the formula (I)



wherein U, T, and W independently represent C or S(O)<sub>m</sub> or a

Art Unit: 1626

pharmaceutically acceptable salt, or solvate thereof.

The closest prior art of record is by Foster et al (CA113:131729). Foster discloses a compound N-methyl-[5-methyl-2-(thienyl)thio]-benzenepropanamine. The prior art compound is patentably distinct from the instantly claimed compounds of formula (I), because the prior art compound has Y as methyl group, patentably distinct from the instantly claimed compounds wherein the Y is C<sub>1-4</sub>alkoxy, halogen,...

Claim 17 as the method of making the compound of formula (I) has support in the Specification. Therefore, claims 1,3,4,6,13,17, and 22 are allowed.

### ***Telephone Inquiry***

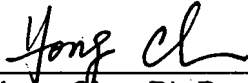
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Chu whose telephone number is 571-272-5759. The examiner can normally be reached on 7:00 am - 3:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

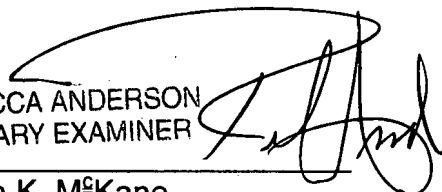
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Art Unit: 1626

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yong Chu, Ph.D.  
Patent Examiner  
Art Unit 1626



REBECCA ANDERSON  
PRIMARY EXAMINER



Joseph K. McKane  
Supervisory Patent Examiner  
Art Unit 1626